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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,465	03/01/2002	Timo Tokkonen	872.0114.UI(US)	9071
29683	7590	10/17/2005		
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER MOE, AUNG SOE	
			ART UNIT 2685	PAPER NUMBER
DATE MAILED: 10/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/087,465	Applicant(s) TOKKONEN ET AL.	
	Examiner Aung S. Moe	Art Unit 2685	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

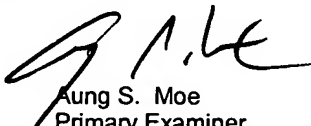
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 26,27,32,33 and 36.
- Claim(s) objected to: 5,7,10,18,19,28 and 38-41.
- Claim(s) rejected: 1-4,6,8,11-17,20-25,29-31,35,37 and 42.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____


 Aung S. Moe
 Primary Examiner
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Response to Arguments

1. Applicant's arguments filed 9/15/2005 have been fully considered but they are not persuasive.

Regarding claims 1, 23 and 37, the Applicant alleged, "it was not obvious to combine a prioritization process used for termination of an application program as described in Chew with Misawa's digital camera. Merely because references can be combined does not mean that it is obvious to combine them."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Chew and Misawa discloses the mobile electronic apparatus (i.e., noted that the PDA of Chew is portable as the Digital Camera of Misawa) containing a memory and a system for prioritizing the user stored files in the memory. In particular, Misawa's system clearly shows the use of memory (34/40) for storing user stored files therein (i.e., note that the image file/priority files can be stored in the memory of Misawa's system based on the user's input; see paragraphs 0024+ of Chew). Further, the Examiner noted that although Misawa discloses a system for prioritizing the user stored files in the memory (see paragraphs 0038+, 0055+ and 0067+), Misawa does not explicitly that "a priority value" is established for the files

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by a combination of at least two of the different prioritization parameters” as recited in present claimed invention.

On the other hand, Chew clearly teaches that the user can stored the different files (i.e., application program files) in the memory (200/202) by using several user input keys or buttons (104/106) or downloaded into the memory of portable device (100) by the user, thus, it is clearly that the files (i.e., the application program files) stored in the memory (200/202) can be considered as “user stored files” as claimed. In addition, Chew clearly teaches the use of means for establishing “a priority value” (i.e., see paragraphs 0033+) for the user stored files (i.e., noted the application programs inputted by the user; see paragraphs 0024+ of Chew) by a combination of at least two of the different prioritization parameters (i.e., noted from the TABLE 1 of Chew and formula “Priority Value = $P1+P2+P3+P4+P5$ ” as shown in Fig. 4 and paragraphs 0033-0039). In view of this, the Examiner continues to opinion that knowing that “a priority value can be established for the files by a combination of at least two of the different prioritization parameters” as taught by Chew, it would have been obvious to one having ordinary skill in the art at the time of the invention was made modify the system of Misawa as taught by Chew, Since Chew suggested in paragraphs 0008+ that such a modification would permit the mobile electronic device to quickly retrieve the priority values, thereby improving the operation and efficiency.

With respect to a combination of Nakai et al., and Chew, the Applicant alleged, “there appears to be no suggestion to use the teaching of Chew to prioritize user stored files and noted suggested in the cited art”.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Chew clearly suggested/taught that "a priority value can be established for the files by a combination of at least two of the different prioritization parameters" (i.e., noted from the TABLE 1 of Chew and formula "Priority Value = $P1+P2+P3+P4+P5$ " as shown in Fig. 4 and paragraphs 0033-0039), therefore, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention was made modify the system of Misawa as taught by Chew, Since Chew suggested in paragraphs 0008+ that such a modification would permit the mobile electronic device to quickly retrieve the priority values, thereby improving the operation and efficiency.

Regarding claim 35, Applicant alleged that Hayduk '833 and Nakai '779 do not anticipated claim 35.

In response, the Examiner respectfully disagrees because both Hayduk '833 and Nakai '779 disclosed the above-mentioned claimed invention.

In particular, Hayduk '833 discloses a system (i.e. Fig. 1, the elements 112) for prioritizing the user stored files (132/136; noted that files 132/136 are stored in the mobile device 102 based on the user's preferences, thus, these files are considered as "user stored files") in the memory (111) relative to one another, the system comprising means for prioritizing (i.e., Fig. 1,

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the elements 112 and 137) the user stored files relative to each other (i.e., the preferences 132 and the list files 136 are related; see paragraphs 0015+) based upon both the second backup parameter (i.e., the parameter of the application APP22; as shown in Fig. 3 and further discussed in paragraphs 0023+ that the application files provide a specific parameter, such as identifying information regarding the business services or some other preference selected by the user) and at least one of the first prioritization parameters (the priorities 134) for each file (i.e., as discussed in paragraphs 0014-0017, the priority values of the user stored files 132/136 can be prioritized by using the application files APP22 and the priorities 134).

In view of the above, the Examiner asserts that Hayduk '833 does in fact show the present claimed invention, and the Examiner will maintain the previous rejection.

With respect to Nakai '779, the Applicant alleged, "there is no disclosure or suggestion of using the priorities shown in table 1 as a first and second prioritization parameter as recited in claim 35.

In response, the Examiner respectfully disagrees because as shown in Figs. 22-24, the priority of the save file is determined based on both the second backup parameter (i.e., the scrapbook information parameters saved as a backup parameter; see Figs. 22-24 and paragraphs 0156+) and at least one of the first prioritization parameters (i.e., noted the one of the previously specified priority parameter, i.e., the default priority parameter, which are not specified or modified during the reduction process) for each file (i.e., see paragraphs 0149-0169).

In view of the above, it is cleared that Nakai '779 does in fact discloses the present claimed invention, thus, the previous rejection is maintained.

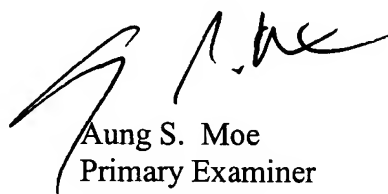
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung S. Moe whose telephone number is 571-272-7314. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aung S. Moe
Primary Examiner
Art Unit 2685

A. Moe
October 11, 2005